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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,932	07/21/2005	Sadanobu Shirai	2005-1129A	9214

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

MERCIER, MELISSA S

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/542,932

Applicant(s)

SHIRAI, SADANOBU

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,10,12,17,18,20 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11,13-16,19 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 8,19 and 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7-21-05, 10-14-05, 11-28-06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of support A: a support of a fiber film prepared by heat fusing a soft plastic resin on a composite fiber prepared by entangling a natural fiber on a soft plastic fiber, in the reply filed on January 5, 2007 is acknowledged. The traversal is on the ground(s) that a lack of unity is not established. This is not found persuasive because it is the examiners position that the special technical feature is an aqueous cataplasm. The cataplasm can be support on two different supports and thus neither support would be considered a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-24 are pending in this application. Claims 1-2, 4-6, 8-9, 11, 13-16, 19, 21-23 are under prosecution in the application. Claims 3, 7, 10, 12, 17-18, 20, and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Priority

Applicants claim of priority to PCT/JP04/00641 filed on January 26, 2004 is acknowledged.

Information Disclosure Statement

Receipt of the Information Disclosure Statements filed on July 21, 2005 and October 14, 2005 is acknowledged.

Claim Objections

Claims 8, 19, and 21-23 objected to because of the following informalities:

aminomethasilicate is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4 and 9 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

M.P.E.P. § 2163 states, "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention...one must define a compound by 'whatever characteristics sufficiently distinguish it'. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."

While the specification describes a species of the instantly claimed cellulose derivatives at p. 9, it does not describe a sufficient number of species as to convey possession of the entire genus encompassed by cellulose derivatives.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-2, 4-6, 8-9, 11, 13-16, 19, 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what an aqueous cataplasm would encompass. Dictionary.com discloses a cataplasm is "a medical dressing consisting of a soft heated mass of meal or clay that is spread on a cloth and applied to the skin to treat inflamed areas or improve circulation etc". The examiner is interpreting the limitation of the claim to include any part of the cataplasm, which includes water as being aqueous.

The term "hardly soluble" in claims 4, 8-9, 19, 21-23 is a relative term, which renders the claim indefinite. The term "hardly soluble" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Regarding Claims 8, 19, and 21-23, it is unclear if the amounts in parentheses are limitations to the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-6, 11, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al (US Patent 6,221,382).

Ishida discloses a sheet pack having a multilayer moisture permeable support including a hydrophobic layer and a hydrophilic layer (abstract). The material applicable to the multilayer support is a fabric or a laminate of a fabric and a film. The material of the hydrophobic may be comprised of polyethylene (column 4, lines 30-35). The hydrophilic layer may be comprises of a natural fiber such as cotton. A mixture of a hydrophilic fiber with a hydrophobic fiber such as polypropylene or polyethylene may be used (column 4, lines 35-45). Methods for the lamination of the fabric and film include thermally laminating a fabric and a resin film which has been previously dissolved in a

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solvent or thermally molten (column 7, lines 30-36). Example 1 further discloses the method of making the sheet pack and discloses a cosmetic substance impregnating the sheet having a water content of 17-19% by weight (column 10, lines 1-50).

Ishida does not disclose the weight of the adhesive layer laminated on the support.

The instant claims differ from the references only in the specific weight of the adhesive layer. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the amount of the adhesive layer utilized in order to provide a cataplasm with the desired properties in order to provide the optimum therapeutic effect. Therefore, it is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

Claims 4, 8-9, 13, 15, 19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al (US Patent 6,221,382), in view of Misumi et al (US Patent 6,224,899).

The teaching of Ishida are discussed above and applied in the same manner.

Ishida does not disclose the composition of the adhesive layer.

Misumi discloses a composition comprises a polyacrylic acid compound, a polyvalent metal component and water, wherein the content of water is 75 to 95% by

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weight. Also disclosed are an adhesive cooling composition shaped into a sheet (abstract). The amount of polyacrylic acid present is 1-20% by weight (column 3, lines 50-51). Suitable examples of the polyvalent metal component are aluminum, including aluminum hydroxide (column 3, line 53- column 6, line 2). The amount of polyvalent metal compound is 0.01-20% by weight (column 4, lines 16-17). The adhesive cooling composition may further contain a polyhydric alcohol, such as glycerin, propylene glycol, and butylenes glycol (column 5, lines 9-25). The amount of polyhydric alcohol can be 0.001-30% by weight (column 5, lines 26-27). Additionally, an acid may be added to the adhesive composition to adjust the pH of the composition (column 4, line 66-column 5, line 1).

The instant claims differ from the references only in the specific weight of the water present in the adhesive layer. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the amount of the adhesive layer utilized in order to provide a cataplasm with the desired properties in order to provide the optimum therapeutic effect. Therefore, it is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as a Whole has been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Furthermore, It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58

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CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that patches would comprise adhesive layers, for application of compositions to the skin, it would have been obvious to combine these adhesives with the expectation that such a combination would be effective. Thus, combining them flows logically from their having been individually taught in prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

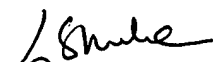
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MSMercier



Gollamudi S. Kishore, PhD
Primary Examiner
Group 1600